

**REMARKS**

Claims 1,4, 17-19 and 21-24 are all the claims pending in the application, prior to the present Amendment.

Claims 1,4, 17-19 and 21-24 have been objected to as informal.

The Examiner states that claims 1, 4, 17-19, and 21-23 contain the word "each" which according to the Examiner is redundant. Applicants have amended claims 1, 4, 19 and 23 to delete the word "each." Applicants have canceled claims 17, 18 and 21.

The Examiner states that there are two claim 19 in the claim listing, and that for the purpose of this office action, the second claim 19 is labeled claim 20. In the above listing of the claims, applicants have corrected the listing by listing the second claim 19 as claim 20.

The Examiner states that claim 24 should be amended to depend on claim 20 instead of claim 19. Applicants have so amended claim 24.

In view of the above, applicants request withdrawal of the objections to the claims.

The Examiner has set forth four rejections of the claims over prior art, with each rejection being based on US 6,410,640 to Fukunaga et al as a primary reference.

The four rejections are as follows:

Claims 1, 5-7,16, 18, 20 and 24 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Fukunaga et al (US 6,410,640) as evidenced by Singh (US 4,960,844).

Claims 17 and 19 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Fukunaga et al (US 6,410,640) as evidenced by Singh (US 4,960,844), in view of Emmerling et al (US 5,554,709).

Claims 4, 12, 15 and 22 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Fukunaga et al (US 6,410,640), as evidenced by Singh (US 4,960,844), in view of Suzuki et al (EP 0538881), in further view of Okamoto et al (WO 03/011978, see English Language equivalent US 7,115,695).

Claims 21 and 23 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Fukunaga et al (US 6,410,640), as evidenced by Singh (US 4,960,844), in view of Suzuki et al (EP 0538881), in further view of Okamoto et al (WO 03/011978, see English Language equivalent US 7,115,695), in further view of Emmerling et al (US 5,554,709).

Applicants submit that the cited prior art does not disclose or render obvious the presently claimed invention and, accordingly, request withdrawal of these rejections.

Applicants have amended claims 1 and 4, which are the only independent claims in the application, to recite the presence of an amine compound, a filler and a plasticizer, and to recite the amounts of these components, the amount of the tin carboxylate (B), and to recite that polymer (A) is a polyoxypropylene polymer. Applicants have canceled claims 12 and 15 to 18.

Support for amended claim 1 can be found in original claim 6, and page 33, lines 1 to 4, page 39, lines 2 to 6, page 44, line 23 to page 45, line 14, page 56, line 24 to page 57, line 1, and the Examples of the specification.

Support for amended claim 4 can be found in previously presented claim 15, and page 35, lines 20 to 33, page 39, lines 2 to 6, page 44, line 23 to page 45, line 14, page 56, line 24 to page 57, line 1, and the Examples of the specification.

Support for amended claim 20 can be found at page 10, line 16 to page 12, line 11, and the Examples of the specification.

Support for new claim 25 can be found at page 29, lines 9 to 11 of the specification.

Support for new claim 26 can be found at page 35, lines 6 to 8 of the specification.

As applicants have previously explained in the Amendment Under 37 C.F.R. § 1.114(c) filed on May 26, 2009, the present invention provides a curable composition capable of giving a cured article excellent in heat resistance and curability. As applicants have previously discussed, in a conventional curable composition comprising a hydrolyzable silyl group-containing organic polymer which has an amide bond, a curable composition providing a rapid curing rate and excellent heat resistance simultaneously is not known.

On the other hand, the present inventors found that heat resistance is improved when a tin carboxylate or the carboxylic acid having a low activity for forming urethane bond is used as the catalyst, and further found that a silanol-condensable activity is increased when the tin carboxylate or the carboxylic acid having a specific molecular architecture about the carbon atom adjacent to the carbonyl group is used as the catalyst. As a result, the present inventors achieved the present invention having a rapid curing rate and excellent heat resistance simultaneously. Applicants rely on the arguments set forth in the Amendment Under 37 C.F.R. § 1.114(c) filed on May 26, 2009.

Applicants have argued that the present invention achieves unexpected results and submitted a Declaration Under 37 C.F.R. § 1.132 with the Amendment of May 26, 2009 in support of the obtaining of unexpected results.

In the present Office Action, the Examiner states that the evidence, in the form of the Examples of the present specification and the Declaration Under 37 C.F.R. § 1.132 that was previously submitted, is not of commensurate scope with the claims it is offered to support. The

Examiner sets forth a number of reasons why he considers the evidence to be not commensurate in scope with the claims.

First, the Examiner states that the polymers bearing the  $\text{-NR—C(=O)-}$  groups tested in the evidence is far more limited than the broader organic polymer (A) of the instant claims. The examples in the Declaration are all based on a polyoxypropylene polymer.

In response, applicants have amended claims 1 and 4 to direct them to a polyoxypropylene polymer as the organic polymer (A).

The Examiner also states that the catalysts, and the amounts of catalysts tested in the evidence are far more limiting than the tin carboxylate (B), and the amount of tin carboxylate (B) of the present claims.

In response, applicants have amended claim 1 to recite the amount of tin carboxylate as 0.5 to 10 parts by weight in relation to 100 parts by weight of the polyoxypropylene polymer (A), and have amended claim 4 to state that the amount of component (B) is 0.5 to 10 parts by weight in relation to 100 parts by weight of the polyoxypropylene polymer (A). In addition, applicants enclose a new Declaration Under 37 C.F.R. § 1.132 which shows varying amounts of the tin carboxylate, and which additionally employs pivalic acid as a tin carboxylate. As shown in the new Declaration, when pivalic acid was used, the same effect was provided as the case where tin neodecanoate or neodecanoic acid was used. In the Examples in the new Declaration, the amount of the component (B) was 1.5 to 10 parts by weight in relation to 100 parts by weight of the polyoxypropylene polymer (A). Applicants submit that the Examples in the new Declaration, together with the previous Declaration and the Examples in the present specification support the range and the catalysts of the amended claims.

The Examiner has also stated that the compositions of the evidence contain high amounts of fillers and plasticizer, which are not present in the composition of the present claims.

In response, applicants have amended claims 1 and 4 to recite the presence of filler and plasticizer, and to recite amounts. Although the examples in the Declarations did not vary the amounts of filler and plasticizer, applicants submit that one of ordinary skill in the art would recognize that the amounts of filler and plasticizer would have little effect on thermal stability.

With respect to claim 4, applicants have previously argued that Okamoto et al do not use in a curable composition any free carboxylic acid that has a quaternary carbon atom adjacent to the carbonyl group. The Examiner responds to this argument by stating that one cannot argue references individually where rejections are based on combination of references. However, since the main basis for the Examiner's reliance on Okamoto et al against claim 4 was that Okamoto et al allegedly taught the use of a free carboxylic acid that has a quaternary carbon atom adjacent to the carbonyl group, it is entirely appropriate to point out the deficiency in the Okamoto et al. Further, since Okamoto et al fail to disclose the feature upon which the Examiner relied, the combination of Okamoto et al with the other references failed to suggest the present claims. Thus, applicants were not attacking references individually as the Examiner alleges, but were attacking the combination of references.

In the present Office Action, the Examiner further states that Okamoto et al teach the advantages of carboxylic acids having quaternary carbon atom adjacent to the carbonyl group, and one of ordinary skill in the art would have envisaged these advantages in the derivatives of the carboxylic acids, as well as the free carboxylic acids of Okamoto et al. This statement of the Examiner, however, does not address applicants' argument that Okamoto et al do not teach or

suggest the use in a curable composition of a free carboxylic acid that has a quaternary carbon atom adjacent to the carbonyl group.

In particular, as applicants have previously discussed, the portions of Okamoto et al which the Examiner has referred to are part of a description of component (B) of Okamoto et al which begins at column 14, line 35, where Okamoto et al state that component (B) is a carboxylic acid metal salt. See also, column 2, lines 55-60, column 14, lines 6 to 65 and claims 1 and 5 of Okamoto et al for a description of component (B).

Thus, the various carboxylic acids disclosed at column 15, line 61, to column 16, line 8 of Okamoto et al are examples of the carboxylic acid functionality in such acid metal salts. Okamoto et al do not disclose the use as a catalyst of any free carboxylic acid wherein a carbon atom adjacent to the carbonyl group is a quaternary carbon atom.

The advantages set forth by Okamoto et al relate to the making of the metal salt as a catalyst, and not to the use in a curable composition of a free carboxylic acid that has a quaternary carbon atom adjacent to the carbonyl group as a catalyst.

In view of the above, applicants submit that the present claims are patentable over the cited prior art and, accordingly, request withdrawal of each of the prior art rejections.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

AMENDMENT UNDER 37 C.F.R. § 1.111  
Application No.: 10/568,616

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Respectfully submitted,

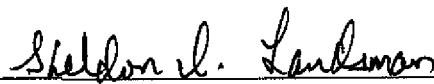
SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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Sheldon I. Landsman  
Registration No. 25,430